UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	.CONFIRMATION NO.
09/457,842	12/09/1999	SATORU SAWADA	12924(JA998-	8134

7590 07/22/2005	EXAMINER
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ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/457,842	SAWADA ET AL.
	Examiner	**Art Unit**	
	Cristina Owen Sherr	3621	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
> THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
>   after SIX (6) MONTHS from the mailing date of this communication.
> - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
>   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
>   earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1)☒ Responsive to communication(s) filed on _17 May 2005_.
- 2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
- 3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4)☒ Claim(s) _1-8,10-16 and 21-24_ is/are pending in the application.
  - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5)☐ Claim(s) _____ is/are allowed.
- 6)☒ Claim(s) _1-8,10-16 and 21-24_ is/are rejected.
- 7)☐ Claim(s) _____ is/are objected to.
- 8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9)☐ The specification is objected to by the Examiner.
- 10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a)☐ All   b)☐ Some * c)☐ None of:
      - 1.☐ Certified copies of the priority documents have been received.
      - 2.☐ Certified copies of the priority documents have been received in Application No. _____.
      - 3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).
    - * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _06/13/05_.
- 4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to applicant's amendment filed May 17, 2005.

Claims 12, 3, 10, and 13 have been amended. Claims 9, and 17-20 have been

canceled. Claims 1-8, 10-16 and 21-24 are pending in this case.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 17,

2005 has been entered.

Information Disclosure Statement.

3.   The information disclosure statement (IDS) submitted on June 13, 2005 is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is

considering the information disclosure statement.

Response to Arguments

4.   Applicant's arguments with respect to claims 1-8, 10-16 and 21-24 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter that the applicant regards as his invention.

6.   Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

7.   Specifically, claim 22 as written is dependent on claim 20, a canceled claim.

Because it is unclear which claim it is actually dependent upon, appropriate correction

of claim 22 is required.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-8, 10-16, 21, and 23-24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ginter et al (US 6,253,193) in view of Saito (US 6,744,894).

10.   Regarding claim 1 -

Ginter discloses a data charging system for charging for the use of object data, the

system comprising a server machine for generating contents containing a plurality of

types of object data, an IC card including a recording medium for recording charging

data for paying for said object data and recognition data for identifying the type of the

object data; and client machines for receiving said contents generated by the server

machine; the client machine including a data charging apparatus for using said IC card

to charge for the use of said object data by using said charging data and said

recognition data which have been recorded on said IC card; a separator for separating

said object data from said contents, a recognition logic for identifying the specific type of said separated object data by using said recognition data which has been read out from the recording medium, an accounting logic for dynamically charging for the use of said separated object data, based on the type of data said separated object data is, and by using said charging data which has been read out from the recording medium, and a writing logic for writing, as part of said charging data in the recording medium, the results of charging for the use of said separated object data (e.g. col 3 ln 20-50).

11.   Ginter does not disclose but Saito does, a data charging apparatus comprising data reading logic for reading out recognition data and charging data from a recording medium (e.g. col 4 ln 5-40).

12.   It would be obvious to combine the teachings of Ginter and Saito since both are in the same field and in order to obtain greater security in data management.

13.   Regarding claim 24 –

Ginter discloses a data charging system wherein: the content generator also puts recognition data in said contents; and the object data is identified based on the recognition data in said contents and said recognition data read from the recording medium (e.g. col 22 ln 20-35).

14.   Regarding claim 2 –

Ginter discloses a content generator on a server machine for embedding digital watermarks in object data of a specific type and generating contents in a data charging system which records, on an IC card recording medium, charging data used for paying for object data contained in said contents and said IC card being used by a client .

machine to charge dynamically only for the use of the object data received by the client

machine and embedded with said digital watermarks, based on the specific type of data

said object data is, and by using said charging data and said recognition data which

have been recorded in said recording medium (e.g. col 3 ln 20-50).

15.   Ginter does not disclose, but Saito does, recognition data used for identifying the

type of object data in said contents (e.g. col 4 ln 5-40).

16.   It would be obvious to combine the teachings of Ginter and Saito since both are

in the same field and in order to obtain greater security in data management.

17.   Regarding claim 3 –

Ginter discloses in a data charging system including a server machine which records,

on an IC card recording medium, charging data for paying for object data and contained

in contents and recognition data used for identifying the type of the object data in said

contents and pays for the use of said object data by using said charging data and said

recognition data which has been recorded in the recording medium, a client machine

including a data charging apparatus comprising: a data reading logic for reading said

recognition data and said charging data from said recording medium, a separator for

separating said object data from said contents, based on the type of data said

separated object data is, and data by using said charging data which has been read out

from the recording medium, and

a writing logic for writing, as part of said charging data in the recording medium, the

results of charging for the use of said separated object data (e.g. col 3 ln 20-50).

18.   Ginter does not disclose but Saito does, a recognition logic for identifying the

type of said separated object data by using said recognition data read out from the

recording medium an accounting logic for dynamically charging for the use of said

separated object (e.g. col 4 ln 5-40).

19.   It would be obvious to combine the teachings of Ginter and Saito since both are

in the same field and in order to obtain greater security in data management.

20.   Regarding claim 4-8 –

Ginter discloses the data charging apparatus according to Claim 3, wherein said

contents comprise said object data and said recognition data for recognizing this object

data, said separator separates said object data and said recognition data from said

contents, said recognition logic recognizes said object data, based on said recognition

data which has been separated from said contents and on said recognition data which

has been read out from said recording medium, and said accounting logic charges for

said object data by using said charging data which has been read out; further

comprising a watermarking logic for embedding digital watermarks in said object data

which has been separated from said contents, wherein said separator separates said

object data and said recognition data from said contents, said recognition logic

recognizes said object data, based on said recognition data which has been separated

from said contents and on said recognition data which has been read out from said

recording medium, and said accounting logic charges for said object data embedded

with said digital watermarks; wherein a digital watermark is embedded in said object

data in said contents, said data charging apparatus further comprising a means for

detecting if said object data is embedded with said digital watermark, said separator

separating said object data and said recognition data from said contents, said

recognition logic recognizing said object data, based on said recognition data which has

been separated from said contents and on said recognition data which has been read

out from said recording medium, and said accounting logic charging for said object data

only if said object data is found to be embedded with said digital watermark; wherein

said charging data recorded on said recording medium contains at least payment data

which indicates payment made in advance for the use of said object data, and said

accounting logic charges for the use of said object data within limits of an amount

indicated by said payment data contained in said charging data; and wherein said

charging data recorded on said recording medium further contains unit price data

representing an accounting unit for the use of said object data and a price

corresponding to the accounting unit, said data charging apparatus comprising an

accounting unit detection logic for detecting unit accounting amount data which

represents an amount of said accounting unit for the object data which has been

separated from said contents, said accounting logic charging within the limits of the

amount indicated by said payment data, based on said unit price data contained in said

charging data which has been read out and on the wait accounting amount data which

has been detected (e.g. col 23 ln 30-55).

21.   Regarding claim 10 –

Ginter discloses a data charging method for using a server machine for generating

contents which contain a plurality of types of object data and recognition data used for

the identifying of this object data in the generated contents, recording, in an IC card

including a recording medium, charging data for paying for said object data and the

recognition data used for identifying the specified type of the object data, and charging

for the use of said object data by using said charging data and said recognition data

which have been recorded, comprising the steps of delivering the generated contents to

a client machine: and using the client. machine for reading said recognition data and

said charging data from said 1C card, separating said object data from said contents,

using the IC card to charge dynamically for the use of said separated object data, based

on the specified type of data said object data is, and by using said charging data which

has been read out from the recording medium; and writing into the IC card as part of

said charging data, the results of charging for the use of said recognized object data

(e.g. col 3 In 20-50).

22.   Ginter does not disclose but Saito does, identifying the specified type of said

separated object data by using said recognition data that has been read out from the IC

Card (e.g. col 4 In 5-40).

23.   It would be obvious to combine the teachings of Ginter and Saito since both are

in the same field and in order to obtain greater security in data management.

24.   Regarding claims 11-12 –

25.   Ginter discloses a data charging method according to Claim 10, wherein said

object data in said contents are embedded with digital watermarks, comprising the steps

of separating said object data and said recognition data from said contents; recognizing

said object data, based on said recognition data which has been separated from said

contents and on said recognition data which has been read out from said recording

medium; detecting said digital watermark embedded in said object data; and charging

for said recognized object data only by using said charging data which has been read

out if said object data is found to be embedded with said digital watermark; and

comprising the steps of separating said object data and said recognition data from said

contents; recognizing said object data, based on said recognition data which has been

separated from said contents and on said recognition data which has been read out

from said recording medium; embedding digital watermarks in said separated object

data; and charging for the use of the object data embedded with said digital watermarks

by using said charging data which has been read out (e.g. col 25 ln 30-45).

26.   Regarding claims 22-23 –

Ginter discloses, a method according to Claim 11, further comprising the step of

embedding in said contents information about the digital watermarks; and wherein the

embedding step includes the step of embedding in said contents instructions for

embedding the contemn with said digital watermarks (e.g. col 25 ln 45-60).

27.   Regarding claim 13 –

Ginter discloses, in a data charging apparatus of a data charging system which uses a

server machine to record on an IC card including a recording medium, charging data

used for paying for object data of a specified type and contained in contents and

charges for the use of said object data by using said charging data and said recognition

data which have been recorded; computer program product enabling a client machine

that has received said content to execute the steps of reading said recognition data and

said charging data, separating said object data from said contents, identifying the

specified type of said separated object data by using said recognition data which has

been read out from the IC card using said IC card to charge dynamically for the use of

said separated object data, based on the specific type of data said separated object

data is, and by using said charging data which has been read out from the recording

medium, and writing into the IC card, as part of said charging data, the results of

charging for the use of said recognized object data into said recording medium (e.g. col

3 ln 20-50).

28.   Ginter does not disclose but Saito does recognition data used for identifying the

type of the object data in said contents (e.g. col 4 ln 5-40).

29.   It would be obvious to combine the teachings of Ginter and Saito since both are

in the same field and in order to obtain greater security in data management.

30.   Regarding claims 14-16 –

Ginter discloses the computer program product according to Claim 13, wherein said

contents contain said object data and said recognition data used for recognition of the

object data, said object data and said recognition data are separated from said contents

in said separation step, said object data is recognized in said recognition step, based on

said recognition data which has been separated from said contents and on said

recognition data which has been read out from the recording medium, and a charge is

made for said object data in said charging step by using said charging data which has

been read out; wherein the computer is made to execute the step of embedding digital

watermarks in said object data which has been separated from said contents, said

object data and said recognition data are separated from said contents in said

separation step, said object data is recognized in said recognition step, based on said

recognition data which has been separated from said contents and on said recognition

data which has beg read out from the recording medium, and a charge is made for said

object data embedded with said digital watermarks in said charging step; and wherein

said object data in said contents are embedded with digital watermarks, the computer is

further made to execute the step of detecting that said object data is embedded with

said digital watermarks, said object data and said recognition data are separated from

said contents in said separation step, said object data is recognized in said recognition

step, based on said recognition data which has been separated from said contents and

on said recognition data which has been read out from the recording medium, and

a charge is made for said object data in said charging step only if said object data is

found to be embedded with said digital watermark (e.g. col 29 ln 10-45).

31.   Examiner's note: Examiner has cited particular columns and line numbers in

the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may be applied as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

Conclusion

32.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

33.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

34.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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